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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,611	08/24/2005	Johnny Nilsson	1935-00154	4849
26753 7590 03/17/2008 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
EXAMINER PASSANTIL SEBASTIANO				
ART UNIT 3711		PAPER NUMBER		
MAIL DATE 03/17/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/524,611

**Applicant(s)**

NILSSON ET AL.

**Examiner**

Sebastiano Passaniti

**Art Unit**

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-16 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office action is responsive to communication received 12/13/2007 – election.

Claims 5-27 remain pending.

Applicant's election of the Group I set of claims (claims 5-16 and 22-27) in the reply filed on 12/13/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 17-21 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Following is an action on the MERITS:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-16 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (U.S. Patent 5,269,518) in view of applicant's disclosure. Specific to claims 5, 6, 9, 10, 22, 23, 25 and 26, Kobayashi shows a grip-weighted putter, wherein the mass of the club head represents about 64% of the total mass of the putter, including the head, shaft and grip. See the discussion in columns 5 and 6 of

Kobayashi. Although Kobayashi is silent about the exact dimension of the length (L) representing the position of the pivot point (O) away from the longitudinal axis of the head (Kobayashi, Figure 2), and the exact values for the mass of the shaft divided by the length (claims 11-16 and 27), it is clear that the claimed dimensions have been tailored to a preferred value based upon the optimization of Steiner's theorem, which provides values for the moment of inertia of the head and shaft, as detailed by the applicant [SPECIFICATION, pages 8-10]. Moreover, the values disclosed by the applicant are noted as "preferred" values. Hence, there would not appear to be any criticality associated with any of the claimed dimensional values. Of further interest is the fact that the claim language does not exclude modification of the grip portion of the shaft in consideration of the specific moment of mass inertia of the combined head and the shaft. Note, the grip is attached to the shaft and is therefore an integral part of the shaft. Kobayashi already recognizes the benefits of increasing the mass moment of inertia through the addition of additional weight near the grip end of the putter so that the effects of a pendulum swing may be enhanced. In view of the above reasoning, one of ordinary skill in the art would have found it obvious to modify the device in Kobayashi by arranging the weight distribution of the club so that weight is removed from the head end of the club, the motivation being to facilitate swinging of the club. Specific to claims 8 and 24, Kobayashi is clearly provided with a grip at one free end of the shaft opposite the head end. Specific to claims 7 and 22, as the shaft in Kobayashi appears to be disclosed as formed of uniform cross-section and of the same material throughout, it is clear that the mass of the shaft is evenly graduated along the length of the shaft.

Claims 5-16 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Getts (U.S. Patent 5,460,378, already of record) in view of Hannon (U.S. Patent 5,554,078, already of record) or Bloom (U.S. Patent 6,506,128) and applicant's disclosure. At the outset, it is noted that this rejection based upon Getts in view of Hannon or Bloom is not intended to be a generic or catchall rejection that simply provides a cursory review of the claims. Rather, the examiner has completed an extensive review and search of the elected claims and has concluded that the claims comprise a mix of structure and non-critical dimensional limitations. Getts shows the invention substantially as claimed and includes a displaceable weight mounted on the exterior of the shaft. The applicant has discussed that a displaceable mass in the form of a tubular sleeve arranged to be attached on the exterior of the shaft at a desired distance from the head will enable the moment of inertia of the club to be adjusted to a player's liking [SPECIFICATION, page 5]. Getts, however, does not detail the specific, claimed numerical requirements for the mass moment of inertia of the head (claims 5, 6, 9, 10, 22, 23, 25 and 26), the location of the pivot point away from the longitudinal axis of the head (claims 5 and 22), and the exact values for the mass of the shaft divided by its length (claims 11-16 and 27). It is clear that the claimed dimensions have been tailored to a preferred value based upon the optimization of Steiner's theorem, which provides values for the moment of inertia of the head and shaft, as detailed by the applicant [SPECIFICATION, pages 8-10]. Moreover, the values disclosed by the applicant are noted as "preferred" values. Hence, there would not appear to be any criticality associated with any of the claimed dimensional values. Of further interest is

the fact that the claim language does not exclude modification of the grip portion of the shaft in consideration of the specific moment of mass inertia of the combined head and the shaft. Note, the grip is attached to the shaft and is therefore an integral part of the shaft. Moreover, each of the teaching references to Hannon and Bloom recognize the benefits of using a counterbalance weight in the upper shaft portion. Each of Hannon and Bloom indicates that the value selected for the weight of the counterbalance ultimately depends upon the weight of the club head itself and the desired performance characteristics and/or the trajectory to be imparted to a ball. See column 7, line 50 through column 8, line 32 and column 9, line 56 through column 10, line 10 in Bloom. See the "SUMMARY OF THE INVENTION", column 4, line 48 through column 7, line 51 in Hannon. Where a parameter optimized is recognized as being result-effective, that optimization is normally considered an obvious matter to one of ordinary skill in the art. See In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Under the circumstances here, the applicant's claimed dimensions involve no more than the optimization of a result-effective variable and would have been obvious to one having ordinary skill in the art, based on the teachings of Getts in view of Bloom or Hannon. It would have been obvious to modify the device in Getts by adjusting the mass of the counterbalance weight in order to adjust the mass moment of inertia, the motivation being to tailor the club head and shaft weight depending upon the individual performance needs of a golfer. Specific to claims 8 and 24, Getts is clearly provided with a grip at one free end of the shaft opposite the head end. Specific to claims 7 and 22, as the shaft in Getts appears to be disclosed as

formed of uniform cross-section, it is clear that the mass of the shaft is evenly graduated along the length of the shaft.

### ***Response to Arguments***

Applicant's arguments with respect to claims 5-16 and 22-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Further References of Interest***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figure 3 in Plutt. Note the tapered shaft in Klein. See the weighted grip end in Appledorn. The patent to Benzel shows added weight away from the head portion. Hull weights different shaft sections, as desired. See Figure 1 in Benoit. The patents to Leumi, Teas and Ascardi show mallet-style clubs, of interest.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sebastiano Passaniti/  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 02, 2008